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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,438	07/31/2001	Shin Hiwasa	1214-011212	1754

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EXAMINER

LAVILLA, MICHAEL E

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/890,438

Applicant(s)

HIWASA, SHIN

Examiner

Michael La Villa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 19, 21-23 and 25 is/are rejected.
- 7) ☐ Claim(s) 24 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 February 2005 has been entered.

Claim Objections

2. Claims 16 and 26 are objected to because of the following informalities: At line 2 of Claim 16, the word "consisting" should read "consists". At line 3 of Claim 26, the added word "and" should be replaced with a comma and a comma should be introduced before the already present "and". Appropriate correction is required.
3. Claims 21 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Regarding Claim 21, the claimed diferrocenium derivative cation suggests broadening of the scope of the subject matter of Claim 16 for the reasons provided in the section 112, second paragraph rejection below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
5. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 21 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - I. Regarding Claim 21, it is unclear what is meant by the phrase "diferrocenium derivative cation". It is unclear whether this cation is necessarily encompassed by the cation of formula (I) of Claim 16. If not, the claim is also objected to as not being further limiting of Claim 16 for the claimed subject matter would be broader than the independent claim from which it depends.
 - II. Regarding Claim 25, it is unclear whether the two compounds of the mixture must constitute compounds from different Markush group elements or whether the two compounds can be of the same Markush group element. Hence, would two different methylol compounds be a suitable mixture?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
8. A person shall be entitled to a patent unless –
9. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 16, 19, and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Shouzaki et al. USP 6,100,352 for the reasons of record in the Office Action mailed on 15 October 2004 and the comments provided below.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 16, 19, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shouzaki et al. USP 6,100,352 for the reasons of record in the Office Action mailed on 15 October 2004 and the comments provided below.

Allowable Subject Matter

14. Claims 24 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
15. Claim 25 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
16. Neither the prior art of record nor the reviewed prior art teaches or suggests the claimed subject matter of Claims 24-26. Particularly, reactions systems consisting of materials of formula (I) of Claim 16 and cationically polymerizable organic substances are not taught or suggested. Shouzaki's reaction systems include additional catalytic ingredients. It is also remarked that applicant's claims omit solvent. Hence, the subject matter of Claims 24-26 is allowable.

Response to Amendment

- I. In view of applicant's amendments, the claim objection of the Office Action mailed on 15 October 2004 is withdrawn.
- II. In view of applicant's amendments and arguments, applicant has traversed the section 112, second paragraph rejection of the Office Action mailed on 15 October 2004. Rejection is withdrawn, but related rejection is presented above for the reasons provided.
- III. In view of applicant's amendments and arguments, applicant traverses the section 102 and 103 rejections over Shouzaki of the Office Action

mailed on 15 October 2004. While applicant has limited the claimed materials by introducing "consisting" language, Shouzaki nevertheless teaches the claimed materials as isolated materials to be combined in forming the catalyst of Shouzaki. According to applicant's disclosure, such materials inherently possess the claimed catalytic qualities. Hence, even though the catalyst of Shouzaki requires additional ingredients to be effective as compared to the claimed catalytic material, the claimed compounds are disclosed as an isolated component of Shouzaki. Hence, Shouzaki teaches these materials.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Tuesday, Thursday, and alternating Fridays.
18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa
16 April 2005



MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER